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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,616	02/21/2002	Andreas Wieck	101769-141/tesa AG 1527-C	9569
27384	7590	01/24/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/081,616

Applicant(s)

WIECK ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 5, 2006 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1 – 12 and 14 - 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “wherein the homogeneous opaque polymer backing includes means for web edge guided optical recognition for dispensing the punched shaped parts” in claims 1, 2 and 18 is unclear, which render the claims vague and indefinite. It is unclear from both the claim language and the specification how the polymer backing is homogeneous when one of the methods for optically recognizing the article for dispensing the punched shaped parts in the specification uses the a color difference in the backing material. The backing material being homogeneous contradicts the use of optical recognition.

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The phrase “providing the polymer backing with means for web edge guided optical recognition for dispensing the punched shaped parts” in claim 11 is unclear, which renders the claim vague and indefinite. It is unclear from both the claim language and the specification how the polymer backing is homogeneous when one of the methods for optically recognizing the article for dispensing the punched shaped parts in the specification uses the a color difference in the backing material. The backing material being homogeneous contradicts the use of optical recognition.

Claims 3 – 10, 12 and 14 – 17 are also rejected under 35 U.S.C. 112 2<sup>nd</sup> paragraph due to their dependency on the above rejected claims.

Correction/clarification is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 12 and 14 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greuse et al. in view of Higgins.

Greuse et al. disclose a protective material with punched shaped parts (Figs. 3-4) as well as a method of using the protective material (see Abstract) wherein a double sided adhesive tape is placed on top of the protective material (Fig. 1, #14) from which punch shaped parts are punched out by a kiss-cut punching tool ("die-cut" - Col. 4, lines 18-19) wherein the protective material comprises an opaque colored polymer backing sheet having a top and a bottom face (note that the Examiner has defined the combination of layers #16 and #18 (the backing layer and release layer) as the polymer backing sheet - see Fig. 1). The backing sheet comprises a backing layer which itself may comprise colorants, there by making it homogeneous, (Col. 7, lines 52-56) and further comprises an anti-adhesive dyed silicone layer along the top face of the backing sheet (Fig. 1, #16; Col. 3, lines 59-62; Col. 4, lines 1-2; Col. 7, line 64 to Col. 8, line 4) that is in contrast with the color of the opaque backing layer (Col. 7, lines 56-62), the anti-adhesive coating being positioned on the same side of the backing layer as the adhesive tape (see Fig. 1). The color layer is applied over the full area of the backing layer (see Fig. 1; Col. 4, line 49-56). While the preferred colorant material is carbon black (Column 7, lines 64 - 66), Greuse et al. disclose that the colorant could be any variation of a coloration where the coloration does not migrate into either the backing paper or the pressure sensitive material (Column 7, line 67 to Column 8, line 2). Although Greuse et al. teach the use of a backing layer, Greuse et al. fail to explicitly teach that the backing layer is one of polyester, polystyrene, polyamide, or polyimide and also fail to explicitly teach the thickness of the backing layer.

Higgins, however, teach the use of a polymer backing sheet for a release film wherein the backing sheet may be formed from polyester (Col. 2, lines 16-18). The backing sheet, depending

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on the intended application, may range in thickness from 5 to 350 micrometers (Col. 8, lines 43-48). Higgins teaches the use of a polyester polymeric backing sheet in a release liner for the purpose of providing a substrate with improved processability and improved suppression of silicone debris production (Col. 1, lines 35-56). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Greuse et al. and Higgins since each of the aforementioned references are analogous insofar as being directed at silicone release liners and are both concerned with minimizing silicone debris production.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Greuse et al. to include a polyester backing sheet as taught by Higgins in order to provide a substrate with improved processability and improved suppression of silicone debris production.

With regard to the homogeneous opaque polymer backing includes means for web edge guided optical recognition for dispensing the punched shaped parts in claims 1, 2, 11 and 18, Greuse clearly discloses the use of optical recognition of the thickness of the release layer being applied to the backing through the use of color (Column 5, lines 7 – 24) and the use of different colored release liners depending on certain reason as in imperfections in die cutting or printing (Column 7, lines 55 – 62). It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a color change in the backing

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material of Greuse in order to help with the dispensing of the product through optical recognition since Greuse already disclose the use of a color change for another optical recognition system.

Regarding the claims limitations of the opaque color layer is applied to the polymer backing at from about 0.5 to 20 g/m<sup>2</sup>, 4 to 8 g/m<sup>2</sup> or 5 to 7 g/m<sup>2</sup> in claims 9,16 and 17, Greuse et al. teach that the coating density may be modified depending on the desired color of the end product (Col. 5, lines 7-24; Col. 5, lines 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the dyed silicone layer such that it fell within the Applicant's claimed range in order to attain a desired color for the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the silicone release layer such that it falls within the Applicant's claimed range, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greuse et al. in view of Higgins as applied to claims 1 – 12 and 14 – 18 above, and further in view of Posner (USPN 4,506,166).

Greuse et al., as modified with Higgins et al., discloses the claim invention, including the use of the backing sheet having a color layer at the side edges, thereby forming colored strips (Figure 4; Column 4, lines 49 – 56). However, the modified Greuse et al. fails to disclose at least

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one side edge includes holes or notches for guidance for optical recognition during dispensing of the punched shaped parts.

Posner teaches holes or notches (Figure 1, #11) for guidance for optical recognition during dispensing of the punched shaped parts (Column 2, lines 44 – 54) in an article that contains punched articles (Figures 3, 5 and 6, #25) for the purpose of forming individual articles with an adhesive backing that are properly registered for the die cutting operation (Column 1, lines 20 – 24).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the holes or notches in the modified Greuse et al. in order to form individual articles with an adhesive backing that are properly registered for the die cutting operation as taught by Posner.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 – 12 and 14 – 18 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-



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1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*Harold Pyon*  
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1772

*1/20/06*